

REMARKS

The Official Action mailed November 5, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 20, 2006; and December 12, 2006.

However, the Applicant has not received acknowledgment of the Information Disclosure Statements filed on September 4, 2008 (received by OIPE September 5, 2008), and October 2, 2008 (received by OIPE October 6, 2008). The above-referenced Information Disclosure Statements appear in the Image File Wrapper. The Applicant respectfully requests that the Examiner provide initialed copies of the Form PTO-1449s evidencing consideration of the above-referenced Information Disclosure Statements.

Claims 1-28 are pending in the present application, of which claims 1-6, 10 and 11 are independent. Claims 1-11 and 14-28 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 1-28 as obvious based on the combination of U.S. Patent No. 6,670,679 to Hirata and U.S. Patent No. 6,300,656 to Ueno. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1-6 and 10-11 have been amended to recite that a limiter is configured to change a limit voltage by controlling an amount of charge accumulated in a floating gate, which is supported in the present specification, for example, by page 12, lines 19-22. Dependent claims 7-9 and 14-28 have been amended for consistency. The Applicant respectfully submits that Hirata and Ueno, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

Since Hirata and Ueno do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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